

REMARKS

Upon entry of this amendment after final, Claims 2, 4, 6, 8 and 11 will be pending in the present application. Claims 1, 3, 5, 7, 9 and 10 are being canceled herewith without prejudice or disclaimer. Reconsideration of the pending claims is respectfully requested.

Applicants request entry of this amendment after final as placing this case in condition for allowance or better form for appeal. Claims 1, 3, 5, 7, 9 and 10 are being canceled herewith by such amendment after final.

I. Information Disclosure Statement

The Examiner stated that the information disclosure statement filed 4/30/2004 fails to comply with 37 CFR 1.98(a)(2). In a follow-up phone call, Applicants' representative requested further clarification from the Examiner as to the alleged IDS deficiency, and was told that the copy of the reference cited in the IDS was not a part of the scanned image file that the Examiner has access to, and thus the Examiner was not sure if a copy of this reference had ever been received by the Patent Office. He suggested that I resend a duplicated copy of what was sent in with the IDS on 4/30/2004, and Applicants are providing such duplicate copy concurrently herewith.

II. 35 U.S.C. § 102, Anticipation

The Examiner rejected Claims 1, 3, 7 and 9 under 35 U.S.C. § 102 as being anticipated by Ferrel et al. (USPN 5,860,073). This rejection is respectfully traversed, as all such claims have been canceled herewith without prejudice or disclaimer and thus this rejection is now moot.

III. 35 U.S.C. § 103, Obviousness

A. The Examiner rejected Claims 2 and 8 under 35 U.S.C. § 103 as being unpatentable over Ferrel, further in view of Davis et al. (USPN 5,796,952). This rejection is respectfully traversed.

With respect to Claim 2, Applicants show that none of the cited references teach or suggest the claimed step of "*inspecting a plurality of schedule conditions* respectively

related to each of said banner beans *to determine whether each schedule condition is a bean including a banner to be embedded in said page template*” (emphasis added).

Claim 2 is contrasted to Claim 1 (which is being canceled herewith), in that Claim 2 recites that a plurality of *schedule conditions* are inspected to determine whether each schedule condition is a bean including a banner to be embedded in a page template.

Claim 1, in contrast, recited inspecting a plurality of *display conditions* respectively related to each of said pieces of content specifying information to determine whether each display condition has a content to be embedded in said page template. Claim 1 thus was directed to display condition inspection for determining whether to embed content, whereas Claim 2 is directed to schedule condition inspection for determining whether to embed content. The reason for contrasting Claim 1 and Claim 2 is to establish that there exist alternate methods for determining whether to embed content – such as inspecting display conditions and inspecting scheduling conditions. These alternate methods of inspection are important, in that the Examiner states that the claimed step of inspecting a plurality of scheduling conditions is inherent to the teachings of Ferrel at col. 3, lines 45-53. Applicants show that there, Ferrel states:

“Yet another aspect of the present invention is a method of publishing and viewing titles in an electronic publication system including a storage, comprising the steps of creating a content object, creating a style sheet object independent of the content object, linking the style sheet object to a control object, linking the content object to the control object, storing the objects in the storage, retrieving the objects from the storage, applying the linked style sheet to the content, and displaying the styled content with the control.”

As can be seen, what is taught by the cited Ferrel reference is “applying the linked style sheet to the content”. There is no expressed teaching or suggestion of any type of scheduling conditions being used as part of this “applying” step. Nor is such missing claimed step inherent to these teachings, as alleged by the Examiner. “To establish inherency,” the Federal Circuit recently stated, “the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999); see also *Continental*

Can Co. U.S.A., Inc. v. Monsanto Co., 948 F.2d 1264, 1268 [20 USPQ2d 1746] (Fed. Cir. 1991). Such inherency may not be established by “probabilities or possibilities.” *Continental Can*, 948 F.2d at 1269 (quoting *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (C.C.P.A. 1981)). The Examiner states that Ferrel must inherently manage schedule issues for content in order to successfully display disparate pieces of content concurrently. As Applicants have previously shown, an alternate approach to managing content display was recited in Claim 1, where *display conditions* are used to manage content display. Thus, use of *scheduling conditions* to manage content, as recited in Claim 2, is a mere probability or possibility in the cited reference (as it is not explicitly mentioned), and thus it is not at all clear that the missing descriptive matter (use of scheduling conditions for conditional content display) is necessarily present in the thing described by the cited Ferrel reference. Thus, the inherency requirements stated by *Continental Can*, supra have not been met, and Claim 2 is thus shown to have been erroneously rejected.

Further, per The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 by Houghton Mifflin Company, the following is the normal dictionary meaning for “schedule”:

sched·ule *n.*

1. A list of times of departures and arrivals; a timetable: *a bus schedule; a schedule of guided tours.*
2. A plan for performing work or achieving an objective, specifying the order and allotted time for each part: *finished the project on schedule.*

Figure 14 of the present patent application depicts a message flow showing a procedure for defining a schedule (Specification page 36, line 20 – page 37, line 15), and Figures 15-17 of the present patent application depicts a message flow showing a procedure for determining publication of a content to be embedded in a display area and generation of such content (Specification page 37, line 37 – page 40, line 3). The cited reference provides no teaching, suggestion, or hint of any use of scheduling conditions as a part of

content display. Thus, a prima facie case of obviousness has not been made with respect to Claim 2¹.

Applicants further show error, in that Claim 2 does not merely recite managing schedule issues for content, but rather recites a particular type of schedule management. In particular, Claim 2 recites “*inspecting a plurality of schedule conditions ... to determine whether each schedule condition is a bean including a banner to be embedded in said page template*”. The Examiner has not asserted any such bean determination teaching in any of the cited references, but merely alleges that the cited Davis reference describes a banner bean. Applicants respectfully urge that even assuming arguendo that Ferrel inherently teaches management of scheduling issues (which Applicants urge there is no such inherent teaching), and that Davis teaches banner beans, there is still no teaching or suggestion in these combined teachings of *determining whether each schedule condition is a bean including a banner to be embedded* in the page template. Thus, Applicants further show that a prima facie case of obviousness has not been made with respect to Claim 2 as there is at least one additional missing claimed element not taught or suggested by the cited references.

Applicants traverse the rejection of Claim 8 for similar reasons to those given above with respect to Claim 2.

Therefore, the rejection of Claims 2 and 8 under 35 U.S.C. § 103 has been overcome.

B. The Examiner rejected Claims 4 and 10 under 35 U.S.C. § 103 as being unpatentable over Ferrel, further in view of Beauchamp et al. (USPN 6,621,505 B1). This rejection is respectfully traversed.

¹ In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* “A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” *In re Bell*, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

With respect to Claim 4, Applicants show that none of the cited references teach or suggest the claimed feature of “setting schedule information serving as a condition for contents to be displayed in said display area to said part bean”. As can be seen, Claim 4 expressly recites a step of *setting schedule information serving as a condition for contents to be displayed*. As articulated above with respect to Claim 2, the cited Ferrel reference does not teach or suggest any type of schedule information, including the setting of schedule information serving as a condition for contents to be displayed. In rejecting Claim 4, the Examiner acknowledges that Ferrel does not teach this missing claimed step (Office Action dated 7/02/2004, page 7, paragraph 14, where the Examiner states “but Ferrel fails to disclose ... c) setting schedule information serving as a condition for contents to be displayed in said display area to said part bean”). However, the Examiner goes on to state that the cited Beauchamp reference teaches at col. 19, lines 48-67 a communication servlet that regulates HTML output, and that this servlet operates in conjunction with a page-template bean, which must obtain content from a part bean to operate successfully, *along with setting schedule information for the part*. Applicants urge that this cited Beauchamp passage does not teach or otherwise suggest setting schedule information for the part. To the extent the Examiner is alleging that this is inherent in the teachings of Beauchamp, Applicants show that the Examiner has failed to meet the burden of establishing inherency. In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976); *Hansgirg v. Kemmer*, 102 F.2d 212, 40 USPQ 665 (CCPA 1939). Applicants respectfully urge that the Examiner has provided no basis in fact or technical reasoning of why setting scheduling information serving as a condition for contents to be displayed in a display area necessarily flows from the teachings of the cited Beauchamp reference. Thus, the burden of establishing inherency has not been met by the Examiner, per *In re King*, supra.

To the extent the Examiner is not relying upon inherency for such teaching, Applicants request that the Examiner explicitly point out where in the cited Beauchamp reference this schedule setting step is taught, per 37 CFR 1.104(c)(2), as Applicants have thoroughly reviewed this reference and can find no such teaching.

Finally, as every element of the claimed invention has been shown above to not be taught or suggested by the cited references, it is shown that Claim 4 has been erroneously rejected as a prima facie case of obviousness has not been made.

With respect to Claim 10, such claim is being canceled herewith without prejudice or disclaimer.

Therefore, the rejection of Claim 4 under 35 U.S.C. § 103 has been overcome.

C. The Examiner rejected Claim 5 under 35 U.S.C. § 103 as being unpatentable over Ferrel. This rejection is respectfully traversed, as Claim 5 has been canceled herewith without prejudice or disclaimer and thus this rejection is now moot.

D. The Examiner rejected Claim 6 under 35 U.S.C. § 103 as being unpatentable over Ferrel, further in view of Beauchamp, and further in view of Rogers et al. (USPN 6,621,505 B1). This rejection is respectfully traversed.

With respect to Claim 6, Applicants show that the cited reference does not teach or suggest the claimed feature of “an arrangement rule DB for storing an arrangement object for holding said part bean, the display-area specifying information, and *schedule information serving as a condition for said part bean to be displayed in said display area by relating said part bean, the display-area specifying information, and said schedule information with each other*”. The Examiner relies on the teachings of the cited Beauchamp reference as teaching such schedule information. Applicants rebut this assertion for similar reasons to those given above regarding Claim 4.

Therefore, the rejection of Claim 6 under 35 U.S.C. § 103 has been overcome.

E. The Examiner rejected Claim 11 under 35 U.S.C. § 103 as being unpatentable over Davis, further in view of Beauchamp. This rejection is respectfully traversed.

With respect to Claim 11, Applicants show that the cited reference does not teach or suggest the claimed feature of “an arrangement object for holding said banner bean, the display-area specifying information, and *schedule information serving as a condition for said banner to be displayed in a display area by relating said banner bean, the display-area specifying information, and said schedule information with each other*” (emphasis added). The Examiner relies on the teachings of the cited Beauchamp reference as teaching such schedule information. Applicants rebut this assertion for similar reasons to those given above regarding Claim 4.

Therefore, the rejection of Claim 11 under 35 U.S.C. § 103 has been overcome.

IV. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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